Supreme Court, U.S.
FILED
OCT 20 1994
OFFICE OF THE CLERK

No. 94-494

IN THE
Supreme Court of the United States
OCTOBER TERM, 1994

BRISTOL-MYERS SQUIBB COMPANY,
Petitioner,
v.
ZENITH LABORATORIES, INC.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY BRIEF FOR PETITIONER

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WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

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REPLY BRIEF FOR PETITIONER

Zenith's opposition to certiorari makes no attempt to defend the rules of law challenged in the petition or to demonstrate that those rules of law are unimportant or otherwise do not warrant this Court's review. Rather, Zenith argues only that the Federal Circuit's decision does not present either of the two questions raised by the petition (each of which provides an independently sufficient ground for reversal and for review). This argument is patently without merit.

1. With respect to the court of appeals' reversal of the district court's finding of literal infringement, Zenith's brief in opposition confirms that the Federal Circuit decision presents exactly the question raised in the petition. Zenith acknowledges that the Federal Circuit's finding of insufficient proof of literal infringement was "based . . . on a construction of the language of the claim," which, the Federal Circuit held, "claim[ed] a thirty-seven line

diffraction pattern." Br. in Opp. 2, 3. But it is precisely that *legal* ruling about the construction of the common variety of "fingerprint" claims that the petition challenges.

Our position is that a claim like that in the '657 patent is a claim for the chemical structure itself—as the Federal Circuit noted elsewhere in this opinion and in prior opinions (Pet. App. 7a; Pet. 6, 16-17)—with the diffraction data serving only as identifying information. The proper consequence of that construction of such a claim, apparently not disputed by Zenith, is that the amount of such data that must be examined in proving literal infringement is an evidentiary matter to be determined by scientific standards.[1] The Federal Circuit rejected this view and, instead, following Zenith's position, held that a fingerprint claim like the one at issue here claims the diffraction lines themselves rather than the chemical compound. Under that construction, the patent holder must compare all such lines to a set of diffraction lines taken from the accused product—necessarily irrespective of whether *science* requires less than such full comparison to prove that the accused product is identical with the unique chemical structure identified by the lines in the patent claim. The Federal Circuit's ruling on literal infringement thus turned on its resolution of the issue raised in Question 1 of the petition concerning the meaning of this common type of patent claim.

2. With respect to the court of appeals' ruling on the doctrine of equivalents, Zenith is equally off base in suggesting that the decision does not present the question

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[1] In this case, the district court expressly found that the DURICEF sample used by Dr. Brittain to produce his "reference pattern" was scientifically proven to be the chemical structure identified by the diffraction pattern set out in the patent claim. Pet. App. 50a. The Federal Circuit, of course, did not hold that finding to be clearly erroneous; indeed, it nowhere even adverted to the clearly-erroneous standard. And the scientific adequacy of the proof of identity of the chemical structures was not, and could not be, seriously disputed. *See* Pet. 15 n.11.

raised in the petition: whether the doctrine of equivalents protects only those patents serving new functions. Zenith simply asserts that the Federal Circuit's decision rests on "the prosecution history." Br. in Opp. 4. But this assertion provides no reason whatever to doubt that the Federal Circuit decision presents the legal question we have raised.

Quite simply, if Zenith is remaking the legal argument about "prosecution history" that it made below, an argument the Federal Circuit expressly *rejected* (Pet. App. 13a-15a), its discussion has nothing to say about the legal proposition that the Federal Circuit's decision relied on as the basis for its decision. On the other hand, if Zenith is merely saying that the prosecution history shows, as a factual matter, that the patent at issue here serves only a new function (manufacturing ease), the assertion does no more than state the factual premise for applicability of the legal proposition on which the Federal Circuit relied: only new functions count under the doctrine of equivalents.[2] It is that very legal proposition which the petition challenges.

Both issues raised in the petition, in short, are squarely presented by the Federal Circuit's decision. And as the petition argues—for reasons nowhere disputed by Zenith —the Federal Circuit's resolution of these issues is erroneous and important. The rulings conflict with prior decisions and thus create deep confusion about the meaning of patent law on matters of broad application. And they

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[2] As must have been obvious to the Federal Circuit from its own conclusion that manufacturing ease was *not* relied on by the government in issuing the patent (Pet. App. 13a-15a), the patented compound also serves the function of providing treatment of bacterial infections. *See* '657 Patent, col. 1, lines 16-19. (The compound, in addition, provides improved solubility, which inherently affects its pharmokinetics.) The Federal Circuit incorrectly disregarded any function except the new manufacturing function, holding that only new functions are relevant to the doctrine of equivalents.

threaten to impose needless costs on patent holders and courts, create perverse incentives for inventors drafting patent applications, and strip a wide range of patents of necessary and long-established protection grounded in scientific realism. Both rulings should be reviewed by this Court.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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